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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,941	07/08/2005	Salvatore Proto	141483.00007	8698

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EXAMINER

OLSON, LARS A

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/541,941

Applicant(s)

PROTO, SALVATORE

Examiner

Lars A. Olson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07082005</u>  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "for watercrafts", and the claim also recites "in particular of the type with

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fully planing or semi-planing bottom" which is the narrower statement of the range/limitation.

4. On line 3 of Claim 5, the claim does not end with a period, and is thus considered to be incomplete and indefinite.

5. Claim 9 is presented in dependent form, depending from claim 9. It is unclear to the examiner whether the applicant intended to present claim 9 in independent form, or in dependent form. It is assumed by the examiner that the applicant intended to present claim 9 as depending from claim 8.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 6-8 and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Leehey (US 2,926,623).

Leehey discloses the same device for a watercraft as claimed, as shown in Figure 1, that is comprised of one or more transversal elements, defined as Parts #20A, 22A and 24A, that are constrained to a bottom of said watercraft, defined as Part #10, by one or more support elements, defined as Part #20B, 22B and 24B, at a predetermined distance from the bottom of said watercraft, and are configured to

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increase the hydrodynamic lift on said bottom by means of a pressure difference between an upper surface and a lower surface of said transversal elements.

Leehey also discloses the same watercraft as claimed, as shown in Figure 1, that is comprised of a bottom having at least one lifting device, defined as Part #20, 22 and 24, that is comprised of one or more transversal elements, defined as Part #20A, 22A and 24A, that are constrained to a bottom of said watercraft at a predetermined distance from the bottom of said watercraft, and are configured to increase the hydrodynamic lift on said bottom by means of a pressure difference between an upper surface and a lower surface of said transversal elements.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leehey in view of Warner et al. (US 4,345,538).

Leehey, as set forth above, discloses all of the features claimed except for the use of a means for adjusting the inclination of at least a part of a surface of a transversal element.

Warner et al. discloses a hydrofoil device for watercraft, as shown in Figures 1-12, said device, defined as Part #14 or 18, including a flap, defined as Part #40, for adjusting the inclination of at least a part of said device, as shown in Figure 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to utilize a flap on a hydrofoil device, as taught by Warner et al., in combination with the device and watercraft as disclosed by Leehey for the purpose of providing a hydrofoil device with a means for controlling the amount of lift generated by said hydrofoil device.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leehey in view of Sachs (US 4,056,074).

Leehey, as set forth above, discloses all of the features claimed except for the use of a hydrofoil device with at least one support element having an opening.

Sachs discloses a hydrofoil device for a watercraft, as shown in Figures 1-16, said device, defined as Part #68, including at least one transversal member, defined as Part #72, and at least one support element, defined as Part #74, with an opening, as shown in Figure 1.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to utilize a hydrofoil device with a support element having an opening, as taught by Sachs, in combination with the device and watercraft as disclosed by Leehey for the purpose of providing a hydrofoil device with a support element that is lighter in weight.

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***Conclusion***


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Erlykin et al. (US 3,693,570), Coles (US 3,604,384) and Boericke, Jr. (US 2,890,672) disclose hydrofoil devices for watercraft.

12. Any inquiry concerning this communication from the examiner should be directed to Exr. Lars Olson whose telephone number is (571) 272-6685.

lo

April 3, 2006

LARS A. OLSON  
PRIMARY EXAMINER

  
4/3/06